

Appl. No. 09/844,625
Resp. dated Aug. 22, 2005
Reply to Office action of Jun. 22, 2005

REMARKS

Claims 1-28 are pending in the present application. In the Office Action Made Final, mailed June 22, 2005 ("the Final Office Action"), claims 1-28 stand rejected.

Attorney Docket Number

Applicant respectfully requests that the attorney docket number be changed from "WIDC-019/00US" to --15979US01--.

Anticipation Rejection

Claims 1-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,255,800 B1 ("Bork").

Claims 1 and 24 recite "wherein the electronic system does not have to be aware of the first protocol to be in communication with the device". Claim 11 recites "the electronic system not having to be aware of the first protocol to be in communications with the device". Claim 16 recites "wherein the personal computer does not have to be aware of the first protocol to be in communication with the device".

The Final Office Action states that "the electronic system does not have [to] be aware of the first protocol to be in communication with the device because the protocol translation is performed by the Bluetooth USB Firmware. Since Bluetooth USB firmware is already in place to provide protocol translation, the electronic device does not need to be aware of the first protocol of the device." Final Office Action at page 4.

Applicant respectfully submits that the logical argument presented in the Final Office Action makes assumptions not described in Bork. For example, just because Bork describes a USB driver 62 with Bluetooth USB firmware and a USB device controller, as illustrated in FIG. 19, it does not necessarily follow that the electronic system (which is alleged to be the PC 10) does not have to be aware of the first protocol (which is alleged to be the Bluetooth protocol).

Applicant respectfully notes that the Final Office Action did not provide a citation to Bork which clearly states that "[s]ince, Bluetooth USB firmware is already in place to provide

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protocol translation, the electronic device does not need to be aware of the first protocol of the device". See Final Office Action at page 4 (without citation to Bork).

Applicant respectfully requests that the Examiner reconsider the persuasiveness of the evidence between (A) the conclusion reached in the Final Office Action without any citation to Bork that, just because there is Bluetooth USB firmware in the USB driver 62, the electronic system (which is alleged to be the PC 10) does not have to be aware of the first protocol (which is alleged to be the Bluetooth protocol), and (B) the following supported statements from Bork to the contrary:

Computer 10 also requires Bluetooth profiles 60, such as found in the Bluetooth Profile Specification, which can be found at www.Bluetooth.com or www.Bluetooth.net, hereby incorporated by reference, which are applications that insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility at the application layer so that if, for example, data synchronization is required, the computer knows how to do data synchronization with mobile device 54 (see for example, FIG. 21 in the Profile Stack section on page 171 of the Bluetooth Profile Specification). Computer 10 can be enhanced by the addition of an application 60 that enables the user to configure, control, and use all Bluetooth devices that are connected to a computer (e.g., application such as Bluetooth Advisor—see WinHEC 99 White Paper submitted herewith, or Bluetooth Neighborhood—see also www.Bluetooth.net). In the event that computer 10 is to be coupled to cradle 46 via a Universal Serial Bus "USB", the computer 10 also requires a USB driver 62 in addition to a PC operating system 61, such as Microsoft's Windows 98.

Bork at col. 6, lines 26-36 (bold underlining of "Computer 10" and "requires" added for emphasis).

Applicant respectfully submits that, since PC 10 requires (i.e., it is not optional so as to permit the alleged characterization of the Bluetooth USB Firmware as set forth in the Final Office Action at page 4) Bluetooth profiles 60 and other Bluetooth applications to "insure compatibility between devices—not just at the physical layer or protocol layer, but compatibility

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at the application layer", the electronic system (which is alleged to be the PC 10) must be aware of the first protocol (which is alleged to be the Bluetooth protocol).

Applicant respectfully requests that the arguments presented in the Final Office Action be reconsidered, and that the anticipation rejection based on Bork be withdrawn with respect to claims 1-28.

Bork Teaches Away from Claimed Elements

As is clear from the above arguments and the arguments made in the Response to Office Action dated February 22, 2005 (which Applicant hereby incorporates herein in their entirety for reconsideration), Bork not only does not describe at least the above recited elements, but Bork teaches away from at least these claimed elements. This is significant because, should the Examiner find the above arguments persuasive, the Examiner cannot properly combine Bork with another document. Such a combination would be improper under M.P.E.P. § 2145(X)(D)(1) which states that "[a] prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness". Furthermore, such a combination would be improper under M.P.E.P. § 2145(X)(D)(2) which states that "[i]t is improper to combine references where the references teach away from their combination".

Inherency Arguments Not Addressed in Final Office Action

As a courtesy, Applicant reproduces the arguments made in the Response dated February 22, 2005, in which Applicant challenges the improper use of the inherency doctrine. Applicant respectfully submits that these arguments were not addressed in the Final Office Action.

Applicant respectfully challenges the assertion that the elements in claims 6-9, 14, 15, 21-23 and 28 are all inherent. Applicant believes that the Examiner is improperly applying the doctrine of inherency.

The well-known patent law treatise by Donald S. Chisum states that

Federal Circuit decisions emphasize that an anticipatory inherent feature or result must be consistent, necessary, and inevitable, not merely possible.

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Chisum on Patents § 3.03[2][b] (December 2004). The United States Court of Appeals for the Federal Circuit ("the Federal Circuit), which is binding on the United States Patent and Trademark Office, has held that

anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation

Transclean Corp. V. Bridgewood Services, Inc, 290 F.3d 1364, 1373, 62 U.S.P.Q. 2d 1865 (Fed. Cir. 2002). The Federal Circuit has also held that

[i]nherency does not embrace probabilities or possibilities

and that

[i]nherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art.

Trintec Indus., Inc. V. Top-U.S.A. Corp, 295 F.3d 1292, 1297, 63 U.S.P.Q. 2d 1597 (Fed. Cir. 2002).

Applicant respectfully submits that the elements recited in the claims may be probable or possible elements, but are not necessary elements. In other words, if components and relationships other than the elements recited in the claims could be used, then the doctrine of inherency does not apply. For at least the above reasons, it is respectfully requested that the rejections based on the inherency doctrine be withdrawn.

If the Examiner, in a subsequent office action, takes Official Notice or merely alleges that such elements are well-known in the art without any documentary support, then Applicant respectfully draws the attention of the Examiner to M.P.E.P. § 2144.03(E) which clearly states that

[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Accordingly, in such a case, Applicant respectfully submits that the Examiner either must produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner must

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provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

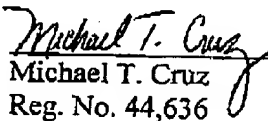
Conclusion

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-28 are in condition for allowance. If anything remains in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: August 22, 2005

Respectfully submitted,


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